

<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>		Application No.	09/660,811
		Filing Date	September 13, 2000
		First Named Inventor	Mark S. Knighton
		Art Unit	2636
		Examiner Name	George A. Bugg
Total Number of Pages in This Submission	9	Attorney Docket Number	4956P003

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form  <input type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> PTO/SB/08 <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Basic Filing Fee <input type="checkbox"/> Declaration/POA <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s)  <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition  <input type="checkbox"/> Petition to Convert a Provisional Application  <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s) <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC  <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)  <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter  <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <div style="border: 1px solid black; padding: 5px; margin-top: 5px;">         -Return receipt postcard (1)       </div>
Remarks		<div style="border: 2px solid black; padding: 10px; text-align: center;"> <b>RECEIVED</b>          AUG 18 2006          U.S. PATENT AND TRADEMARK OFFICE          BOARD OF PATENT APPEALS          AND INTERFERENCES       </div>

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Thomas M. Coester, Reg. No. 39,637 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Signature	<i>Thomas Coester</i>
Date	August 11, 2006

CERTIFICATE OF MAILING/TRANSMISSION			
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Typed or printed name	Susan M. Barrette		
Signature	<i>Susan M. Barrette</i>	Date	August 11, 2006

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Technology Center 2600

# FEE TRANSMITTAL for FY 2005

Patent fees are subject to annual revision.

## Complete if Known

Application Number 09/660,811  
Filing Date September 13, 2000  
First Named Inventor Mark S. Knighton  
Examiner Name George A. Bugg  
Art Unit 2636  
Attorney Docket No. 4956P003

☐ Applicant claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT (\$) 0.00

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ None ☐ Other (please identify):

☒ Deposit Account Deposit Account Number: 02-2666 Deposit Account Name: Blakely, Sokoloff, Taylor & Zafman LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee  
☒ Charge any additional fee(s) or underpayment of fee(s) ☒ Credit any overpayments  
under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20.

## FEE CALCULATION

### 1. EXTRA CLAIM FEES

Total Claims	Extra Claims	Fee from below	Fee Paid
30	30*	0	\$0.00
Independent Claims	7*	0	\$0.00
Multiple Dependent			

Large Entity	Small Entity	Fee Description
Fee Code	Fee Code	
1202 50	2202 25	Claims in excess of 20
1201 200	2201 100	Independent claims in excess of 3
1203 360	2203 180	Multiple Dependent claim, if not paid
1204 790	2204 395	**Reissue independent claims over original patent
1205 300	2205 150	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (1) (\$) 0.00

\*\*or number previously paid, if greater, For Reissues, see below

### 2. ADDITIONAL FEES

Large Entity	Small Entity	Fee Description	Fee Paid
Fee Code	Fee Code		
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet.	
2053 130	2053 130	Non-English specification	
1251 120	2251 60	Extension for reply within first month	
1252 450	2252 225	Extension for reply within second month	
1253 1,020	2253 510	Extension for reply within third month	
1254 1,590	2254 795	Extension for reply within fourth month	
1255 2,160	2255 1,080	Extension for reply within fifth month	
1401 500	2401 250	Notice of Appeal	
1402 500	2402 250	Filing a brief in support of an appeal	
1403 1,000	2403 500	Request for oral hearing	
1451 1,510	2451 1,510	Petition to institute a public use proceeding	
1460 130	2460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
1809 790	1809 395	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810 790	2810 395	For each additional invention to be examined (37 CFR § 1.129(b))	

Other fee (specify) \_\_\_\_\_

SUBTOTAL (2) (\$)

## SUBMITTED BY

## Complete (if applicable)

Name (Print/Type) Thomas M. Coester Registration No. 39,637 Telephone (310) 207-3800  
Signature *Thomas Coester* Date 08/11/06

# FEE TRANSMITTAL for FY 2005

Patent fees are subject to annual revision.

## Complete if Known

Application Number 09/660,811  
Filing Date September 13, 2000  
First Named Inventor Mark S. Knighton  
Examiner Name George A. Bugg  
Art Unit 2636  
Attorney Docket No. 4956P003

☐ Applicant claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT (\$) 0.00

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☐ Check ☐ Credit card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_  
☒ Deposit Account Deposit Account Number: 02-2666 Deposit Account Name: Blakely, Sokoloff, Taylor & Zafman LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee  
☒ Charge any additional fee(s) or underpayment of fee(s) under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20. ☒ Credit any overpayments

## FEE CALCULATION

### 1. EXTRA CLAIM FEES

Total Claims	Extra Claims	Fee from below	Fee Paid
30	30	0	50.00
7	7	0	200.00
Multiple Dependent			

Large Entity	Small Entity	Fee Description
Fee Code	Fee Code	
1202 50	2202 25	Claims in excess of 20
1201 200	2201 100	Independent claims in excess of 3
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SUBTOTAL (1) (\$) 0.00

\*\*or number previously paid, if greater. For Reissues, see below

### 2. ADDITIONAL FEES

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1810 790	2810 395	For each additional invention to be examined (37 CFR § 1.129(b))	
Other fee (specify)			

SUBTOTAL (2) (\$) 0.00

## SUBMITTED BY

## Complete (if applicable)

Name (Print/Type) Thomas M. Coester Registration No. 39,637 Telephone (310) 207-3800  
Signature Thomas Coester Date 08/11/06

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Mark S. Knighton, et al.

Application No.: 09/660,811

Filed: September 13, 2000

For: **DIGITAL IMAGING SYSTEM  
HAVING DISTRIBUTION  
CONTROLLED OVER A  
DISTRIBUTED NETWORK**

Appeal No. 2006-1541

Examiner: George A. Bugg

Art Unit: 2636

**REQUEST FOR REHEARING OF NEW GROUND FOR REJECTION**

Board of Patent Appeals and Interferences  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

In response to the Decision on Appeal mailed June 13, 2006, Applicants respectfully request that the Board reconsider the new basis for rejection of Claims 1-12. A Request for Rehearing of the affirmed rejection as to Claims 23-29 is submitted as a separate paper pursuant to MPEP § 1214.01.

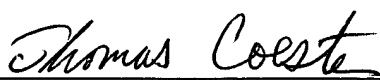
### New Ground for Rejection

The Board has asserted a new ground for rejection as to Claims 1-12 under 35 U.S.C. § 112, first paragraph, asserting that "Nowhere in the original disclosure, as filed, did appellants ever describe the relative positions of the digitizer and orientation fixture as being 'without a predefined relative position,'" Applicants respectfully direct the Board's attention to page 6, lines 5-8 of the application as filed. Here the Applicants state, "Acquiring the orientation fixture may permit, for example, any of automatic calibration of the digitizer, automatic determination of the relative position of the digitizer and orientation fixture, and fixture's orientation or condition." It is non-sensical to suggest that it would be necessary to determine the relative position of the digitizer and orientation fixture if those relative positions were predefined. Thus, Applicants respectfully submits that the description as originally filed supports at least one embodiment in which there is no predefined relative position between the orientation fixture and the digitizer. In view of the forgoing, it is respectfully requested that the Board withdraw this new ground for rejection under 35 U.S.C. § 112, first paragraph.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Dated: August 11, 2006

  
Thomas M. Coester, Reg. No. 39,637

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Susan M. Barrette

8/11/2006  
August 11, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Mark S. Knighton, et al.

Application No.: 09/660,811

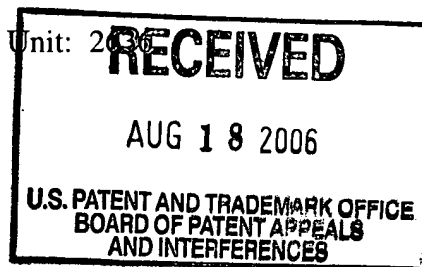
Filed: September 13, 2000

For: **DIGITAL IMAGING SYSTEM  
HAVING DISTRIBUTION  
CONTROLLED OVER A  
DISTRIBUTED NETWORK**

Appeal No. 2006-1541

Examiner: George A. Bugg

Art Unit: 2636



**REQUEST FOR REHEARING PARTIAL AFFIRMANCE OF EXAMINER'S  
REJECTIONS**

Board of Patent Appeals and Interferences  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

In response to the Decision on Appeal mailed June 13, 2006, Applicants respectfully request that the Board reconsider its affirmance of the Examiner in connection with Claims 23-29. A Request for Rehearing of the new ground for rejection as to Claims 1-12 is submitted as a separate paper pursuant to MPEP § 1214.01.

### **Rejection of Claims 23-26 under 35 U.S.C. § 103**

The Board sustained the Examiner's rejection of Claims 23-26 under 35 U.S.C. § 103 as unpatentable over Murphy. Applicants respectfully submit that Murphy fails to teach or suggest the preventing access to the image data by a local user until an authorization is received as claimed. Applicants explicitly note that Murphy does not prevent access to the stored frame. In fact, Murphy explicitly permits viewing of the stored framed. See Murphy, column 15, lines 6-10 without receipt of any authorization. Thus, Murphy fails to teach or suggest preventing access until an authorization is received as claimed. While this fact about Murphy was articulated in the original Appeal Brief as filed, the argument in connection with Claim 20 while it more appropriately applied to Claim 23, it nevertheless demonstrates the non-obviousness Applicants' existing Claim 23 and its dependent claims in light of Murphy. This point was clearly articulated as to Claim 23 in the Reply Brief as filed and this is an appropriate basis for the Board to reconsider and overturn the Examiner. It is therefore respectfully requested that the Board reconsider and overturn the Examiner's rejection of Claim 23 and its dependent claims.

### **The Rejection of Claims 27-29 Under 35 U.S.C. § 103**

In sustaining the Examiner's rejection of Claims 27-29 the Board only addressed one of two aspects of Applicants' argument. Accepting for the sake of argument that Truc can be combined with Migdal and Pito as the Board has determined, the combination of references nevertheless fails to teach or suggest the data analyzer as claimed. The Examiner merely points to a section of the background of the invention of Truc which only indicates that it is desirable to rescan certain images at higher resolution. Contextually throughout Truc, it appears that the examination of the digital representation of the images is conducted by a user and not as a result

of any data analyzer as claimed by Applicants. Thus, it is submitted that the absence of a data analyzer performing the functionality claimed in Claims 27 and 29 could be fatal to the Examiner's rejection. Applicants note that the absence of data analyzer in this combination of references was raised in their initial Brief. Accordingly, Applicants request that the Board reconsider and overturn the Examiner's rejection.

It is further noted with respect to the data analyzer element of Claim 29 that the rescan is conducted using a different capture method. Applicants define different capture methods as, for example, stereoscopy, profilometry, etc. Since these different capture methods do not apply to a two-dimensional medium, it is very clear that Truc offers nothing in this connection. Moreover, neither Pito nor Migdal disclose recapturing using alternative capture methods. For this additional reason, it is respectfully requested that the rejection of Claim 29 be reconsidered and overturned.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

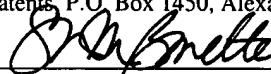
Dated: August 11, 2006

  
\_\_\_\_\_  
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\_\_\_\_\_  
Susan M. Barfette

8/11/2006  
August 11, 2006